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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,427	03/02/2004	Nael Naguib Zaki	1456/3	3775
25297	7590	06/01/2006		
JENKINS, WILSON, TAYLOR & HUNT, P. A. 3100 TOWER BLVD SUITE 1200 DURHAM, NC 27707				
			EXAMINER DELCOTTO, GREGORY R	
			ART UNIT 1751	PAPER NUMBER

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/791,427

Applicant(s)

ZAKI ET AL

Examiner

Gregory R. Del Cotto

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-43 are pending. Claims 44-101 have been canceled. Applicant's response filed 3/13/06 has been entered.

Applicant's election of Group I, claims 1-43 in the reply filed on 3/13/06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Note that, non-elected claims 44-101 have been canceled.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

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Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heimann et al (US 6,281,189) in view of Carbonell (US 2003/0213747).

Heimann et al teach a composition containing at least one soybean oil derived compound and at least one member chosen from the group of drying agent(s), co-solvents, and additives. The composition can comprise methyl soyate, and d-limonene. See Abstract. More specifically, the composition contains from 0.5 to 20% by weight of at least one drying agent, 1 to 30% by weight of at least one cosolvent, additives from 0 to about 25% by weight, and 5 to 75% by weight of methyl soyate. See column 1, lines 45-69. Suitable additives include surfactants (e.g. anionic and nonionic), emulsifiers, antimicrobial compounds, etc. Suitable co-solvents include water, hydrocarbon glycols, and mixtures thereof among others. See column 2, lines 10-65. The compositions can replace toxic chlorinated solvents among other conventional and environmentally undesirable cleaners/solvents. The inventive composition can be employed as a general purpose cleaner, parts cleaner, engine degreaser, tar and asphalt removal, printing press cleaner, metal cleaner, etc. See column 1, lines 30-45.

Heimann et al do not teach the use of a benzoic acid ester or a composition having the specific physical parameters containing a benzoic acid ester, methyl soyate, nonionic surfactant, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Carbonell et al teach environmentally friendly solvents used to dissolve or remove residues and/or substances from substrates wherein the residue and/or substance is contacted with a generally recognized as safe solvent (GRAS) to dissolve the residue and/or substance in the solvent followed by the extraction of the residue and/or substance from the solvent such as by contact with carbon dioxide. See Abstract. These GRAS solvents are environmentally responsible solvents and include benzoic acid ester solvents such as methyl benzoic acid ester, isopropylbenzoic acid ester, methyl salicylate, ethyl salicylate, etc. See paras. 38-45. Preferably, the ester-containing solvent contains at least about 70-99% by weight of the one or more esters. See para. 50.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use a benzoic acid ester solvent in the cleaning composition taught by Heimann et al, with a reasonable expectation of success, because Carbonell et al teach the use of solvents such as benzoic acid esters in similar cleaning compositions and that benzoic acid esters are environmentally friendly solvents and further, Heimann et al teach the use of various cosolvents which would encompass benzoic acid ester solvents.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition containing a benzoic acid ester, methyl soyate, nonionic surfactant, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components,

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because the broad teachings of Heimann et al in combination with Carbonell et al suggest a composition containing a benzoic acid ester, methyl soyate, nonionic surfactant, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Note that, with respect to the pH and flash point of the composition as recited by the instant claims, the Examiner asserts that the teachings of Heimann et al in combination with Carbonell et al would suggest compositions having the same pH and flash point as recited by the instant claims because Heimann et al in combination with Carbonell et al suggest compositions containing the same components in the same proportions as recited by the instant claims.

Claims 1-19, 21-28, and 33-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krawack (US 5,143,639) in view of Carbonell et al (US 2003/0213747).

Krawack teaches a compositions for removing inks and the like from printing machines. See column 1, lines 5-15. The compositions contain a mixture of 50 to 100% by weight of a C1-C5 alkyl ester of an aliphatic C8-C22 monocarboxylic acid or mixture of such esters, 0 to 50% of vegetable oil, 0 to 10% of a surfactant, and a corrosion inhibitor in an amount up to 2% by weight. See column 2, lines 30-60. Suitable surfactants include Dehydol LT7 (heptaethylene glycol monolauryl ether, nonionic surfactant). See column 4, lines 35-50.

Krawack does not teach the use of a benzoic acid ester or a composition having the specific physical parameters containing a benzoic acid ester, methyl soyate,

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nonionic surfactant, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Carbonell et al are relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use a benzoic acid ester in the cleaning composition taught by Krawack, with a reasonable expectation of success, because Carbonell et al teach the use of solvents such as benzoic acid esters in similar cleaning compositions and that benzoic acid esters are environmentally friendly solvents. Note that, it is prima facie obvious to combine two compositions, each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). See MPEP 2144.06.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition containing a benzoic acid ester, methyl soyate, nonionic surfactant, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of Krawack in combination with Carbonell et al suggest a composition containing a benzoic acid ester, methyl soyate, nonionic surfactant, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Note that, with respect to the pH and flash point of the composition as recited by the instant claims, the Examiner asserts that the teachings of Krawack in combination with Carbonell et al would suggest compositions having the same pH and flash point as recited by the instant claims because Krawack in combination with Carbonell et al suggest compositions containing the same components in the same proportions as recited by the instant claims.

Claims 20 and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krawack (US 5,143,639) in view of Carbonell et al (US 2003/0213747) as applied to claims 1-19, 21-28, and 33-43 above, and further in view of Heimann et al (US 6,281,189).

Krawack and Carbonell et al are relied upon as set forth above. However, neither reference teaches the use of an odor-masking agent such as d-limonene in addition to the other requisite components of the composition as recited by the instant claims.

Heimann et al are relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use d-limonene as a fragrance in the composition taught by Krawack, with a reasonable expectation of success, because Heimann et al teach use of d-limonene as an odorant in a similar cleaning composition and further, odorants such as d-limonene are notoriously well-known to those skilled in the art as suitable for use in cleaning compositions and desirable for such use.

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Claims 1-16, 18, 19, 21-26, 33 and 37-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carbonell et al (US 2003/0213747).

Carbonell et al are relied upon as set forth above.

Krawack does not teach the use of a benzoic acid ester or a composition having the specific physical parameters containing a benzoic acid ester, methyl soyate, nonionic surfactant, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Carbonell et al are relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition containing a benzoic acid ester, aliphatic ester, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of Carbonell et al suggest a composition containing a benzoic acid ester, aliphatic ester, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Note that, with respect to the pH and flash point of the composition as recited by the instant claims, the Examiner asserts that the teachings of Carbonell et al would suggest compositions having the same pH and flash point as recited by the instant claims because Carbonell et al suggest compositions containing the same components in the same proportions as recited by the instant claims.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19, 21-28, and 33-43 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 11/248782 in view of Carbonell et al (US 2003/0213747). Claims 1-17 of 11/248782 encompass all the material limitations of the instant claims except for the inclusion of an aromatic ester.

Carbonell et al are relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use a benzoic acid ester solvent in the cleaning composition claimed by '782, with a reasonable expectation of success, because Carbonell et al teach the use of solvents such as benzoic acid esters in similar cleaning compositions and that benzoic acid esters are environmentally friendly solvents and further, '782

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claims the use of various cosolvents which would encompass benzoic acid ester solvents.

This is a provisional obviousness-type double patenting rejection.

Conclusion

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.


Applicant is reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gregory R. Del Cotto
Primary Examiner
Art Unit 1751

GRD
May 29, 2006